



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/093,271	06/08/1998	TOSHIYA FUJII	50L1801/897	7030

24272 7590 04/02/2002

Gregory J. Koerner  
Simon & Koerner LLP  
10052 Pasadena Avenue, Suite B  
Cupertino, CA 95014

EXAMINER

HUYNH, SON P

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/02/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/093,271

Applicant(s)

FUJII, TOSHIYA

Examiner

Son P Huynh

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 20 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1 – 20, 22-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "said system" in line 7 should be "said format manager."

In claim 5, "said set top box" in line 1 lacks antecedent basis.

In claim 22, "the system" in line 1 lacks antecedent basis.

In claim 25, "said set top box" in line 1 lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000; or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 – 6, 21- 26, 41-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikinis (5,929,849).

Regarding 1, Kikinis discloses system for selectively accessing video data and page data, comprising:

ROM 47 and DRAM 48 read on the format manager being claimed; and  
CPU 19 reads on the processor being claimed (see fig. 1<sup>and 2c</sup> and col. 6, lines 1 – 12, col. 12, lines 1-4).

Regarding claim 2, Kikinis discloses the page data is obtained from a distribution electronic network and the video data is obtained from a video source (see fig. 1 and col. 3, lines 32-53).

Regarding claim 3, Kikinis discloses the distribution electronic network is an Internet network (see col. 6, lines 8-12).

Regarding claim 4, Kikinis discloses the display device 51 is a television set controlled by a set top box 11 (see fig. 1 and col. 6, lines 23-26).

Regarding claim 5, Kikinis discloses the set top box 11 includes the processor (CPU 19) and the format manager as discussed in the rejection of claim 1.

Regarding claim 6, Kikinis discloses the set top box 11 is controlled by a wireless remote control device 63 (see fig. 1).

Regarding claims 21-26, the method elements being claimed correspond to the system elements being claimed in claims 1-6 and are analyzed as discussed with respect to the rejection of claims 1-6.

Regarding claim 41, the elements being claimed are directed toward ~~embodiment~~ the method elements of claim 21 in a "computer readable medium." It would have been obvious to one of ordinary skill in the art at the time the invention was made to embody the procedure of Kikinis as discussed with respect to the rejection of claim 21 in a "computer readable medium" in order that the instruction could be automatically performed by a processor.

Regarding claim 42, the system element being claimed correspond to the system elements being claimed in claim 1 and are analyzed as discussed in the rejection of claim 1.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 7-18 and 27-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (US 5,929,849) as applied to claim 1 above, and in view of Arora (US 5,845,299).

Regarding claims 7, Kikinis discloses a system as discussed in the rejection of claim 1. However, Kikinis fails to disclose the format manager copies the page data to create duplicate page data.

Arora discloses a web editor 120 in memory 104 comprising a copy function to copy the page data to create duplicate page data (see figure 11a or col. 9, lines 21-29). Neither Kikinis nor Arora explicitly disclose copying the page data to create duplicate

page data. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis to include a copy of page data function to the format manager as taught by Arora in order to allow user editing the data page without deleting the original page data.

Regarding claim 8, Arora discloses inserting a video tag (image) into the page data (see figure 25)

Regarding claim 9, Arora discloses selectively positions the video tag (image) to vertically locate a video window on the display (see fig. 6)

Regarding claim 10, Arora discloses video tag includes window information for sizing and horizontally positioning the video window (see fig. 3 or col. 10, lines 13-30).

Regarding claim 11, Arora discloses the web editor reformats the page data to avoid video window (see col. 8, lines 29-52).

Regarding claim 12, Arora discloses processor 102 displays the page data on the display device 160 (see fig. 8).

Regarding claim 13, Arora discloses web editor maintains the video window (image) in a stationary position on the display (see 16, lines 53-67).

Regarding claim 14, Arora discloses the video window is selectably positionable on the display (see fig. 11 c).

Regarding claim 15, Arora discloses the video window is selectably sizeable on the display (see col. 10, lines 12-13).

Regarding claim 16, Arora discloses the page data is scrollable with reference to video window on the display device (see col. 7, lines 41-53).

Regarding claim 17, Arora discloses the web editor computes a current reference position each time the page data is changed (see col. 7, lines 40-42).

Regarding claim 18, Arora discloses the web editor uses current reference position as a reference point for locating the video window (see col. 18, lines 47-56).

Regarding claims 27 - 38, the method elements being claimed correspond to system elements being claimed in claims 7 - 18 and are analyzed as discussed in the rejection of claims 7- 18.



7. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis and Arora as applied to claim 17 above, and further in view of Bates (US 6,225,541).

Regarding claim 19, Kikinis in view of Arora disclose a system as discussed in the rejection of claim 17. However, neither Kikinis nor Arora discloses the current reference position is computed by combining a prior reference position and a scroll value.

Bates discloses the current reference position is computed by combining a prior reference position and a scroll value (see figure 6). Therefore, it would have been obvious to one of ordinary skill in the art to modify Kikinis and Arora by computing the new position base on the prior position as taught by Bates in order to quickly locate the position.

Regarding claim 39, the method elements being claimed correspond to the system elements being claimed in claim 19 and are analyzed as discussed in the rejection of claim 19.

***Allowable Subject Matter***

8. Claims 20 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or fairly suggest the scroll value is positive when the duplicate page data is scrolled down, and the scroll value is negative when the duplicate page data is scrolled upwards.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

)  
**Tabata** et al. (US 4,785,296) discloses a window for displaying position information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for

Art Unit: 2611

the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-0377.

Son P. Huynh  
March 19, 2002

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600